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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/461,402	06/05/1995	ANDREW H. CRAGG	94-P0273US02	6448

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MINNEAPOLIS, MN 55403

EXAMINER
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SONNETT, KATHLEEN C

ART UNIT	PAPER NUMBER
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3731

MAIL DATE	DELIVERY MODE
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01/19/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 08/461,402	<b>Applicant(s)</b> CRAGG ET AL.	
	<b>Examiner</b> KATHLEEN SONNETT	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 89 and 91-95 is/are pending in the application.
- 4a) Of the above claim(s) 91-95 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/21/2009</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/21/2009 has been entered.

2. Claims 1-88 and 90 are canceled. Claims 89 and 91-95 are pending. Claims 91-95 are withdrawn from consideration.

3. It is noted that the allowability of claim 89 indicated in the *Ex Parte Quayle* action mailed 7/6/2009 has been withdrawn in view of the rejections presented below.

### ***Change of address***

4. While the Office previously accepted the request for revocation of power of attorney, and change of address, a review of the papers filed are defective. Specifically, the heading for the papers filed list the first named inventor as "Goicoechoa" which is incorrect. In addition, the statement under 37 CFR 3.73(b) is defective, because it fails to list a proper chain of title from the inventors to the current assignee. The Office records indicate at least one assignment record has been omitted.

### ***Priority***

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

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6. This application appears to be a division of Application No. 08/317,763, filed October 4, 1994. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional application or “division.” The divisional application should, among other conditions, set forth the portion of the earlier disclosure that is germane to the invention as claimed in the divisional application and otherwise comply with the requirements of 35 USC 120.

7. 35 USC 120 requires an application for patent be “filed by an inventor or inventors named in the previously filed application...” At this time, it appears that 08/317, 763 had an inventive entity of “Goicoechea, Hudson, and Mialhe”. Application 08/461,402 appears to have an inventive entity of either Cragg and Dake or just Dake (see Interference 104,192 papers). As there is not at least one inventor named in this application named in application ‘763, applicants are not entitled to the priority claim made in the amendment filed on August 21, 2009.

Therefore, **the specification is objected to**, and applicants are required to correct the claim for priority found in the specification.

8. For purposes of this action on the merits, it appears the application is a CIP of 08/312,881 with a filing date of Sep 27, 1994.

***Interference No. 104,083***

9. It appears from the record, that applicant prevailed on a claim of priority against USP 5,575,817 (Martin) in Interference #104,083. However, because that determination was made prior to the decision for Interference #104,192, applicants are no longer considered to have priority over Martin for purposes of this action on the merits. The decision in ‘083 was based upon applicant’s claim of foreign priority, which was subsequently determined to be improper in ‘192. It is also noted that applicant appears to concede the previous priority claim in the most

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recently filed amendment to the specification. Therefore, for purposes of this action on the merits, USP '817 is considered to be relevant prior art.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(f) he did not himself invent the subject matter sought to be patented.

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

11. Claim 89 is rejected under 35 U.S.C. 102(b) as being anticipated by Kornberg (US 4,562,596). Kornberg discloses an apparatus for reinforcing a bifurcated lumen comprising a first section (10; figs. 1 and 8 for example) configured to be positioned within the lumen comprising an upper limb configured to fit within the lumen upstream of the bifurcation, a first lower limb (10A) configured to extend into a first leg of the bifurcation when the first section is positioned in the lumen and a second lower limb (10B) shorter than the first lower limb and configured so that, when the first section is positioned in the lumen, the second lower limb does

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not extend into a second leg of the bifurcation (col. 2 ll. 66-68). It is noted that the language of the first limb "configured to extend into a first leg of said bifurcation when said first section is positioned in the lumen" and a second limb "configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation" is considered a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable (*In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)). Because the device of Kornberg discloses two limbs, one of which is shorter than the other, the apparatus is capable of having the first section positioned in the lumen in a manner such that the first lower limb extends into the first leg of the bifurcation and the second lower limb does not extend into a second leg of the bifurcation. For example, the device shown in fig. 8 of Kornberg can be placed into the lumen such that the length of the device from the upper limb to the bottom of the second lower limb is less than the distance from the upper limb to the second leg of the bifurcation and the length of the device from the upper limb to the bottom of the first lower limb is greater than the distance from the upper limb to the first leg of the bifurcation.

12. Claim 89 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Martin (USP 5,575,817).

13. Claim 89 is rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. See Interference #104,083.

14. Claim 89 is rejected under 35 U.S.C. 102 (g) based upon claim 1 of Patent No. 5,575,817 (Martin). See Interference 104,083 and 104,192.

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15. Claim 89 is provisionally rejected under 35 U.S.C. 102 (g) based upon claims of application 08/463,836 (Fogarty et al.).

16. Count 2 of Int. 104,192 contains applicants' limitations found in original Claims 89 and 90. Claim 90 has been canceled in this application, and only Claim 89 is pending and not withdrawn. Claim 89 is therefore broader than Count 2 upon which applicants lost priority in Interference # '192. As Fogarty et al. have been determined as having been the first to invent the interfering claimed invention, it is appropriate to make a rejection against Claim 89 under 35 USC 102(g).

17. Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,628,783 to Quiachon et al. discloses a bifurcated graft with two branching limbs, one limb shorter than the other.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHLEEN SONNETT whose telephone number is (571)272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KCS 1/11/2010

/Anh Tuan T. Nguyen/  
Supervisory Patent Examiner, Art Unit 3731  
01/15/2010